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| APPLICATION NO.                     | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/010,068                          | 12/06/2001  | Peter M. Karas       | 020375-000610US     | 3210             |
| 20350                               | 7590        | 07/01/2005           | EXAMINER            |                  |
| TOWNSEND AND TOWNSEND AND CREW, LLP |             |                      | POND, ROBERT M      |                  |
| TWO EMBARCADERO CENTER              |             |                      | ART UNIT            |                  |
| EIGHTH FLOOR                        |             |                      | PAPER NUMBER        |                  |
| SAN FRANCISCO, CA 94111-3834        |             |                      | 3625                |                  |

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/010,068

**Applicant(s)**

KARAS ET AL.

**Examiner**

Robert M. Pond

**Art Unit**

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/24/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

The Applicant canceled claim 29, amended claims 1, 6-10, 14, 16, 18, 23, and 25-28, and newly added claim 30. All pending claims 1-28 and 30 were examined in this non-final office action.

### ***Response to Arguments***

#### ***Pertaining to Preliminary Amendment***

Applicant's arguments filed 21 March 2005 have been fully considered and are persuasive. Claims 23-29 in the preliminary amendment were not treated necessitating a non-final office action. The Examiner regrets any inconvenience to the Applicant.

#### ***Rejection under 35 USC 102***

Applicant's arguments with respect to claims 1-28 and 30 have been considered but are moot in view of the new ground(s) of rejection. Small was withdrawn.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. **Claims 1-28 and 30 are rejected under 35 USC 102(e) as being anticipated by Messner (US 6,370,514).**

Messner teaches all the limitations of claims 1-28 and 30. For example, Messner discloses electronic email distribution of electronic gift certificates or coupons to recipients via virtual cards containing messages (please note examiner's interpretation: greeting cards). Messner further discloses:

- receiving selection of the electronic greeting card from a sender: (see at least col. 9, lines 1-17).
- receiving selection of a type of electronic gift from a plurality of gift types: gift certificate for selection among a plurality of gifts or coupon for discounts from among a plurality of gifts (see at least col. 5, lines 19-30; col. 8, lines 17-19; col. 6, lines 59-67).
- receiving payment for the electronic gift from a money handler chosen by the sender: sender chooses payment method (see at least Fig. 1B, col. 8, lines 58-59).

- creating a code indicative of the electronic gift, whereby the code facilitates redemption of the electronic gift: account number with certificate delivered separately from password (see at least col. 6, lines 41-58).
- embedding the code in the electronic greeting card: certificate containing embedded code is delivered with virtual card (see at least col. 6, lines col. 9, lines 1-5).
- embedded code includes a link to the site involved with redemption of the electronic gift: (see at least col. 8, lines 17-34).
- Receiving fee: fee or interest paid to service from central account (see at least col. 12, lines 12-30).
- future time: virtual card with message sent via email to recipient on date specified by sender (see at least col. 9, lines 9-17).
- delivery address: sender provides sender email address. Inherent in Messner are the structures necessary to permit the sender to provide a recipient email address to the online service necessary for the delivery of the email to the recipients email address. For example, the service delivers the virtual card with gift certificate to the recipient via email as previously noted above.
- first identity and second identity for verification: processing recipient email address as noted above as a first identity; sender types personalized question and answer (second identity), presents question

to recipient requesting answer as second identity to validate recipient  
(see at least col. 6, lines 50-58; col. 9, lines 18-50).

- Plurality of gift types: gift certificate value backed by stored value fund (e.g. debit account) (see at least col. 8, lines 58-59).
- HTML: web pages, web server, HTML, and links (see at least col. 2, line 2; col. 12, lines 65-67).
- Money handlers: gift certificate issuer (e.g. brick and mortar store, virtual mall, or voucher server) (see at least col. 8, lines 58-67).
- Payment system: voucher server separate from account server (see at least Fig. 3 (38, 54); col. 7, lines 17-42).
- Computer readable medium: Inherent in Messner are the structures necessary that permit executable code to be embodied on computer readable medium.

Pertaining to claims 17-22, 28, and 30

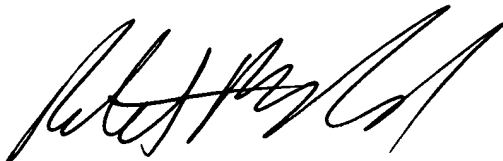
Rejection of claims 17-22, 28, and 30 is based on the same rationale as noted above.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Robert M. Pond', is written over a horizontal line.

Robert M. Pond  
Primary Examiner  
May 27, 2005